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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,511	01/04/2000	GABY MATSLIACH	2559/1F420-US2	9309

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/31/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/477,511

Applicant(s)

MATSLIACH ET AL.

Examiner

Bunjob Jaroenchonwanit

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. In response to the RCE, the Amendment and Argument filed 11/25/03, a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 11/25/03 has been entered. The amendment has been entered and considered. Claims 1-15 are pending for examination.

2. The arguments regarding claims 1, 12 and 13 have been fully considered but they are not persuasive. In the remark, Applicant argued in substance that the MacNaughton does not teach Semi-Public Chat Room, which is a chat session that is designated as selective by a user.

Examiner disagreed, in light of the specification (Page 10, line 16-page 11, line 3), which stated, "When a public chat session is initiated the existence of the chat session is visible to any users who are visiting the same web site. When a private chat session is initiated, the existence of the chat room is invisible to all but the chat session requestor and those users invited to participate in the private chat. "User and Chat sessions initiated by users may further be selectively visible or semi-public. That is, the user or chat session may be visible only to other users with predetermined user profiles that correspond in some way to either the user or the particulars in the chat session." [Emphasis added]. In other words, applicant distinguished the chat rooms by the chat rooms' visibilities. For example, a public chat room is visible to users regardless of their user's profile or invitation, while the private chat room is visible only by invitation, whereas, the semi-public chat room is visible to users who somewhat having similar

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user's profile. In light of the teaching and the aforementioned analogy, MacNaughton teaches all three types of the chat room, the only allow member of community that have some what similar profile, e.g., semi-Public chat room (Col. 8, lines 58-Col. 9, line 5). In another embodiment, MacNaughton teaches a chat room that opens for user regardless s of user's profile or invitation (Col. 9, lines 23-26), and a chat room that requires invitation, e.g., private chat room, (Col. 10, lines 7-16). Further, examiner content that MacNaughton chat system, the system maintain list of users belong to communities, allowing member of community initiated chat session with other community member who share the same interest; defining profile for chat room (Col. 9, line 1-Col. 10, line32). Since, MacNaughton community chat room requires user registering their profile, thus the chat room can not be entered by merely browsing the same web page, as exemplary public chat room in page specification page 10. Thus, reliance upon the limited teaching in the specification, MacNaughton's community chat room, which can be entered by the community member who has some what similar profile, is equivalent to semi-public chat room, which is selectively visible.

In addition, the statement, "User and Chat sessions initiated by users may further be selectively visible or semi-public. That is, the user or chat session may be visible only to other users with predetermined user profiles that correspond in some way to either the user or the particulars in the chat session." [Emphasis added].

In light of the quote above, buddy list mentioned in background of invention, page 5, read on the semi-public chat room, because buddy list allows a user to see another users which subscriber to the same subject of interest, member of a particular group to see is other.

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As to the amendment, applicant excluded relative limitation such as public and private chat room from the claims and added user designating the semi-public chat session selectively visible does not change scope of the claim, which in light of specification does not change scope of the claims. The added limitation has been addressed in the paragraph above. Thus, those citations that applicable for rejecting claims and the previous rejection is respectfully maintain and incorporate by reference.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, other users' profile determined by a user in a chat room to allow the chat room visible by the other user, as claimed in claim 15, must be must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teaches how to make/or use the invention, i.e., failing to disclose how a user in the chat room determining profiles and enable chat visible to other users based on their profile.

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Applicant's disclosure is insufficient to allow one of ordinary skill in the art to make or use the invention without undue experimentation because applicant did not adequately disclose the necessary apparatus to perform the claimed method. See In re Gunn, 190 USPQ 402, 406 (CCPA 1976.) In fact applicant's disclosure broadly suggested that semi0public chat room is visible to users who have somewhat same user's profile. Evidently, there is no passage in the specification to support such claims' language. If applicant believe otherwise, kindly point out the section of the specification that supports any user in the chat room determining other users' profile to enable them to see so called "semi-public chat room".

6. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, for reason set forth in the objection to the specification.

It is suggested that applicant could overcome 112/first paragraph rejection by providing a suitably detailed system diagram (with appropriate cross-indexing in the detailed description to reference numerals on said system diagrams.) No new matter should be added.

7. The text of those sections of Title 35, U.S. Code 112, 102 and 103 not included in this action can be found in a prior Office action.

8. Claims 1-15 are a rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, elements and structural cooperative relationships of elements such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the step and element for receiving information from users; the step and element that providing information to users and their structural cooperative relation. Such omission also render a vague claims, it is unclear, which element in the claim providing such functionalities.

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9. As to claims, claims 1-3, 5-7, 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by MacNaughton et al. (US. 6,020,884).

10. As to claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable under MacNaughton et al. (US. 6,020,884).

11. As to claims 1-14 MacNaughton was applied for claims rejection in the previous rejections, the teaching and citations, which are applicable for rejections, are hereby incorporated by reference.

12. As to claim 15, since there is no support of how user in chat room determining profile of user outside the chat room and enable the chat room visible to the out side user. The claim limitation therefore, read in light of specification, as chat server determines user profile for enabling chat room visible to the profile owner. Such limitation is readily addressed in claim 1. Claim 15, therefore, is rejected by the same rationale set forth in claim 1 rejection.

13. During interview with Attorney of record, Mr. Yanny and Mr. Katz, the Examiner agreed to expedite the prosecution, provided that the claims are amended and clear distinction is fully support by the specification. However, after carefully considered, there is no clear distinction between semi-public chat room and MacNaughton chat room as aforementioned. A telephone call has been made to Mr. Katz to clarify the issue but could not agree upon. Applicant still insisted that the claimed semi-chat room in not taught by MacNaughton. Examiner cannot and will not advance the prosecution based on the semi-public chat room argument. Examiner suggested, writing claims to reflect figures 6a-6d, would have a better chance to secure patent.

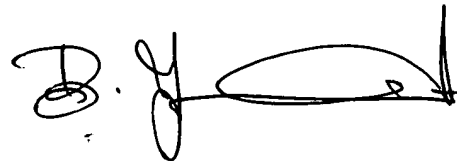
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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

/bj  
December 18, 2003

A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a long horizontal flourish extending to the right.

BUNJOB JAROENCHONWANIT  
PRIMARY EXAMINER